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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,392	05/04/2005	Karl-Heinz Schwonke	Q82965	5710
23373 7590 12/11/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER LONEY, DONALD J	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 12/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/509,392

Applicant(s)

SCHWONKE ET AL.

Examiner

Donald Loney

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement as presented in the last office action, mailed April 17, 2008. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In at least independent claims 1 and 17, the cover layer and base are described as joined in a "non-positive" manner. The specification also refers to this non-positive manner, however, there are no pictures and/or other description that leads one to understand what is meant thereby. The applicant refers to laminating as the process for forming the article, however, this also does not clearly explain what is meant by "non-positive" manner. Laminating, as generally known in the art, typically refers to things being attached in a positive manner? Additionally, there are no drawings that would show what is meant by this description. The examiner will attempt to apply prior art as to the broadest reasonable interpretation of the claims.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 7, 8, 10, 11, 16, 17-19, 22-24, 26, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawka et al (5405675) as presented in the last office action, mailed April 17, 2008.

Sawka et al discloses a base 12 which is embossed and a cover layer 14 there over which has the embossed pattern transferred to the cover layer. See figure 1. They are disclosed as indirectly adhered (column 5, lines 59-65). The examiner deems this equivalent to the applicant's non-positive limitation since it is unclear as to what is meant thereby as explained above. In addition, since a print layer 20 is inter-deposited there between the examiner deems this another way of meeting the non-positive manner limitation. Regarding claims 2, 3, 18 and 19, printing 20 is shown between the layers. With regards to claim 7 and 22, the base is formed of more than two films (12, 22, 23 and/or 24). With regards to claim 16, adhesive film 24 is shown in figure 1.

5. Claims 1-11 and 14-33 are rejected under 35 U.S.C. 102(b) as being anticipated by either Wiley et al (4409280) or Martin et al (5773127) as presented in the last office action, mailed April 17, 2008.

Both Wiley et al and Martin et al disclose a base which is embossed and a cover layer there over which has the embossed pattern transferred to the cover layer. See figure 3 in Wiley et al and figure 5 in Martin et al. Since a print layer is inter-deposited there between the examiner deems this a way of meeting the non-positive manner limitation. This rejection is made to specifically address the limitations of claims 4, 5, 20

and 21 wherein there is another layer between the base and cover layer. See layer 21 and 27 in Wiley et al and layers 3' and 5 in Martin et al. Regarding claims 2, 3, 18 and 19, printing is shown between the layers in both references. With regards to claim 7 and 22, the base is formed of more than two films as shown in the figures.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Wiley et al, Sawka et al or Martin et al as presented in the last office action, mailed April 17, 2008.

The primary reference teaches the invention substantially as recited except for the specific profile dimensions of the embossments per claims 12 and 13. They are silent as thereto. See the 35 U.S.C. 102 rejections above.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the embossments of the recited profile dimensions since this would merely involve a change in size and/or shape which is generally within ordinary skill in the art. See MPEP 2144.04IV.

#### ***Response to Arguments***

10. Applicant's arguments filed August 18, 2008 have been fully considered but they are not persuasive. The applicant argues that the "non-positive" recitation means force-connected as defined in the attached German word definition included in the last response. However, it is still unclear as to what the structure thereof is in order to understand the scope of the claims. The applicant argues that Sawka et al fails to teach the cover layer is joined in a non-positive manner to the embossed base sheet. However, since Sawka et al does disclose laminating with heat and pressure in example 2 there would be a force applied due to the pressure applied. The examiner deems this a non-positive manner (which the applicant defines as a force connection) since it is unclear as to what the applicant means thereby. The applicant also argues the process

in Sawka et al is not capable of transferring an embossed structure from the base to the underside of the cover layer, however, since the cover layer 14 conforms to the base as seen in the figures it does transfer the embossed structure to at least the under side of the cover layer since the cover layer conforms thereto. The applicant argues that Wiley et al and Martin et al disclose chemical embossing which would not form a structure joined in a non-positive manner (i.e. by force as defined by the applicant). However, Wiley et al does disclose mechanical embossing in the last line of the Abstract which would involve at least some form of force applied thereto (see Sawka et al for example). Martin et al discloses that the chemical embossing allows the layer(s) to expand against a heated drum (column 5, lines 5-11) which would also include at least some force applied thereto by the expansion of the layer against the drum.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Donald J. Loney/  
Primary Examiner  
Art Unit 1794

DJL;D.Loney  
12/04/08